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INTELLECTUAL PROPERTY ADMINISTRATION

FORT COLLINS, CO 80527-2400

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

07/22/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/763,625

Applicant(s)

ALMOG ET AL.

Examiner

LAWRENCE D. FERGUSON

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38, 40-43 and 45-47 is/are pending in the application.
- 4a) Of the above claim(s) 48-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38, 40-43 and 45-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed April 29, 2008.

Claims 38 and 43 were amended and claim 44 was cancelled rendering claims 38, 40-43, 45-47 pending with claims 48-58 withdrawn as a non-elected invention.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections – 35 USC § 103(a)

3. Claims 38 and 40-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lever et al. EP 0458481 in view of Ellery et al (U.S. 5,631,078).

Lever discloses a substrate suitable for printing a toner image thereon comprising a film or sheet made of cellulose ester, which may also be inclusive of plastic material, such as biaxially oriented polypropylene (BOPP), polyethylene, polyethylene terephthalate (PET), and polycarbonate (page 2, lines 23-58) as in claim 44. Lever also discloses a underlayer coating, the lacquer layer, comprises a polymer material which has crosslinkable functional groups, such as amine groups (page 3, lines 2-9), and an overlayer coating, the toner image receptive layer, comprises a polymer material, such as styrene butadiene copolymer or ethylene acrylic acid copolymer, to which a toner image can be fused and fixed (page 4, line 42-page 5, line 20) as in

claims 41, 42, 46 and 47. In claim 38, the phrase, “toner image can be fused and fixed” constitutes a ‘capable of’ limitation and that such a recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform. The overlayer coating is substantially free of wax and particulate matter. The outer surface of the multilayer composite comprising printing media (page 3, lines 22-25).

Although Lever does not explicitly disclose the substrate comprising the film is paper, Ellery teaches a film having paper is conventionally made using cellulose ester fibers (column 1, line 53 through column 2, line 6). Lever and Ellery are combinable because they are related to a similar technical field, which is thermoplastic films. Therefore, it would have been obvious to one of ordinary skill in the art for the substrate of Lever to be a paper substrate, as Ellery teaches paper is conventionally made from cellulose ester fibers to improve the transparency of the sheeting material (column 1, lines 12-13) as in claim 38.

Concerning claims 40 and 45, Lever does not disclose the overlayer has to be free of particulate matter; however, particulate matter, is a well-known optional additive for the image receiving substrates. Addition of these additives depends on the application of the substrates. The absence of evidence that the claimed overlayer being free of particulate matter is critical. It would have been obvious to one of ordinary skill in the art to decide whether to use or not use the optional additives, such as particulate matter, when it is applicable. The cited document discloses a composition prepared from the same components as claimed in the present application except for the particular amounts and parameters. The claimed parameters are expressed differently and thus may be distinct from what is disclosed, therefore, it is incumbent upon applicants to establish that such difference is unobvious. Therefore, it would have been

obvious to one having ordinary skill in the art at the time of the invention to employ the particular amounts and/or parameters as claimed, since it is well-established that merely selecting proportions and ranges is not patentable absent a showing of criticality. In re Becket, 33 USPQ 33, and In re Russell, 169 USPQ 426. Concerning claim 43, because Lever discloses a print media having a substrate coated with an underlayer and overlayer having the same materials, it is expected for the underlayer to have a high affinity for the substrate, for the toner to have a high affinity for toner and for the underlayer and overlayer to have high affinity for each other, absent any evidence to the contrary.

Response to Arguments

4. The objection of the abstract is withdrawn due to Applicant's amending the abstract to comply with the proper language and format for an abstract of the disclosure.

Applicant's arguments regarding the rejection made under 35 U.S.C. 103(a) as being unpatentable over Lever et al. EP 0458481 in view of Ellery et al (U.S. 5,631,078) have been considered but are unpersuasive. Applicant argues neither Lever or Ellery teach or suggest a coated paper substrate or a paper based print media including a paper substrate. Although Lever does not explicitly disclose the substrate comprising the film is paper, Ellery teaches a film having paper is conventionally made using cellulose ester fibers (column 1, line 53 through column 2, line 6). Therefore, it would have been obvious to one of ordinary skill in the art for the substrate of Lever to be a paper substrate, as Ellery teaches paper is conventionally made from cellulose ester fibers to improve the transparency of the sheeting material (column 1, lines 12-13) as in claim 38. Applicant further argues thermoplastic products are not typically used for printing

Art Unit: 1794

a toner image as they tend to be different from those of ordinary paper based on its chemical and physical structure. Lever discloses a substrate suitable for printing a toner image thereon comprising a film or sheet made of cellulose ester (page 2, lines 23-58) where Ellery teaches a film having paper is conventionally made using cellulose ester fibers (column 1, line 53 through column 2, line 6). Applicant's assertion that thermoplastic products are not typically used for printing a toner image is unsubstantiated, especially since Lever teaches a substrate suitable for printing a toner image thereon.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks, can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/L. Ferguson/
Patent Examiner
AU 1794

/KEITH D. HENDRICKS/
Supervisory Patent Examiner, Art Unit 1794